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10/524,689	01/12/2006	Dieter Barfurth	265280US0PCT	9121
22850	7590	10/21/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
10/21/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/524,689

**Applicant(s)**

BARFURTH ET AL.

**Examiner**

MARC S. ZIMMER

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 5-9, 11, 12, 14 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The Examiner will re-iterate his earlier assessment as to how the claims should be treated: "vinylalkoxysiloxane" will be considered merely to be a siloxane polymer bearing both vinyl groups and alkoxy groups that are not necessarily on the same silicon atom. Likewise, an alkylalkoxysiloxane is interpreted as embracing those siloxane polymers having alkyl substituents and alkoxy substituents. This same treatment extends to all of the other combinations of polymers delineated in (b) through (f).

Applicant has amended claim 1 to stipulate that the siloxane compounds outlined in (a) through (f) are mixtures of compounds and, thus, the Examiner's earlier position that the recitation of a single polymer having all of the groups possessed by any of the combinations (a) to (f) would anticipate the claims no longer applies.

### ***Claim Objections***

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. To the extent that the polymer compounds in (a) through (f) are provided as mixtures, it is impossible that that any one of the pair could represent 100% by weight of the composition.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 10, 13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chambers et al., U.S. Patent Application Publication No. 2004/0209972. The abstract discloses dual-curable silicone compositions comprising a blend of a polysiloxane bearing terminal mercaptoalkyl- and alkoxy groups and a polysiloxane bearing terminal vinyl- and alkoxy groups. Insofar as the former also comprises alkyl substituents, it may aptly be described as an alkylalkoxysiloxane and thus the mixture (a) is anticipated.

Paragraph [0039] identifies other material that may be incorporated into the silicone host matrix including fillers (silica, talc) and plasticizers. Therefore, claims 2, 15, and 16 are anticipated. (Claim 13 is regarded as being anticipated because the silicone composition itself is peroxidically crosslinkable.)

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Allowable Subject Matter***

Claims 5-9, 11-12, 14, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Concerning claims 12, 17, and 18, these claims are being interpreted in such a fashion that it is being presumed that the so-called peroxidically crosslinking rubber compounds must be a compound different from the vinyl/acryl-functional polysiloxanes of claim 1. Chambers does not mention admixing the elastomer composition disclosed therein with another distinct peroxidically-curable rubber.

Yatsuyanagi et al., U.S. Patent # 6,337,361, is cited as being of interest, but not especially germane to, the instant claims for their description alkylalkoxysiloxanes corresponding to formula (IIa) in claim 6.

Also noteworthy is Yatsuyanagi et al., JP 10-273559 which, likewise, teaches similar filler treating agents. However, it could not be ascertained whether or not a mixture of alkoxysiloxanes is fairly suggested by this document as the machine translation was unclear on this matter. The Examiner has requested a full translation of this reference, the merits of which will be more comprehensive judged upon receipt of the translation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 14, 2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796